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WAGNER, MURABITO & HAO LLP
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EXAMINER

WANG, THOMAS D

ART UNIT PAPER NUMBER

2122

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,173

Applicant(s)

STEFANIK ET AL.

Examiner

Thomas D. Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the application filed January 25, 2002.
2. Claims 1-43 have been examined.

Priority

3. The priority date considered for this application is January 25, 2002.

Claim Objections

4. Claim 37 is objected to because of the following informalities: at line 8, the bullet item 'd' that is listed at the end of item 'c', needs to be listed on a separate line.

Appropriate correction is requested.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13, 20, 35 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13, 20, 35 and 40 recite the limitation "Bluetooth" in line 2.

BLUETOOTH, which is a wireless technology, is a trademark and is used to specify only the source of the so-labeled products, namely Bluetooth Special Interest Group (SIG).

The presence of a trademark or trade name in a claim is not per se improper under 112/2d. However, it is important to recognize that a trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus a trademark or

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trade name does not identify or describe the goods associated with the trademark or trade name.

If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 112/2d. *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982).

The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-10, 14-17, 21, 37 and 42-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Heath (US 6,006,034, hereinafter Heath).

9. With respect to claim 1, Heath discloses *a method of software distribution comprising:*

- *demarking (selecting) a subset of a plurality of files (objects) stored on a ...to denote a demarked plurality of files (E.g. see Heath – col. 1:50-55, selecting to download and update on the needed; and at col. 4:46-48 selectively identify and retrieve required components); and*
- *transferring information of said demarked plurality of files to... (E.g. see Heath – Fig. 3A Retrieve catalog file from server using launcher 302, and at col. 4:46-48).*

10. With respect to claim 2, Heath further discloses *wherein said demarked plurality of files comprises executable program instructions (E.g. see Heath – col. 1:56-62, executable codes, library files).*

11. With respect to claim 3, Heath further discloses *wherein said demarked plurality of files comprises non-executable information (E.g. see Heath – col. 1 56-62, parameter files, and data files).*

12. With respect to claim 4, Heath further discloses *wherein said information of said demarked plurality of files comprises a rating of said demarked plurality of files (E.g. see Heath – Fig. 3A:302-306, Fig. 2B, col. 3:7-20, Information in the downloaded catalog file, which at least includes the list of names and version... information such as rating, for the purpose of sharing, could very well included in the catalog);*

13. With respect to claim 5, Heath further discloses *wherein said information of said demarked plurality of files comprises titles (names) of said demarked plurality of files (E.g. see Heath – col. 3:12-15, includes the list of names and version id).*

14. With respect to claim 6, Heath further discloses *wherein said information of said demarked plurality of files comprises storage requirements of said demarked plurality of*

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files (E.g. see Heath – col. 4:64-5:4, the catalog file includes at 324 a version identification, code or data size).

15. With respect to claims 7 and 8, Heath further discloses *wherein said information of said demarked plurality of files comprises an alphanumerical summary of said demarked plurality of files* (E.g. see Heath – col. 3:7-20, Information in the downloaded catalog file, which at least includes the list of names and version... information such as rating, for the purpose of sharing... included in the catalog, col. 4:64-5:4).

16. With respect to claim 9, Heath further discloses *wherein said information of said demarked plurality of files comprises a universal resource locator (hypertext link) for said demarked plurality of files* (E.g. see Heath – col. 3:20-27).

17. With respect to claim 10, Heath further discloses *wherein said information of said demarked plurality of files comprises an estimated transfer time for said demarked plurality of files* (E.g. see Heath – Fig. 5:508; col. 7:5-32).

18. With respect to claim 14, Heath discloses *a method of software distribution comprising:*

- *demarking a subset of a plurality of files stored on a first hand held computer system to denote a demarked plurality of files* (E.g. see Heath – col. 1:47-55, selecting to download and update on the needed; and at col. 4:63-65 selectively identify and retrieve required components);
- *transferring information of said demarked plurality of files to a second hand held computer system* (E.g. see Heath – Fig. 3A Retrieve catalog file from server using launcher 302, and at col. 4:46-48);

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- *on said second hand held computer system, selecting a selected list indicating at least one of said demarked plurality of files (E.g. Heath – Fig. 2B:23-29); and*
- *responsive to said c), automatically transferring files indicated by said selected list to said second hand held computer system (E.g. Heath – col. 1:49-55, automatically selecting to download and update).*

19. With respect to claim 15, Heath further discloses *wherein at least one of said files corresponding to said selected list transferred from said first hand held computer system to said second hand held computer system is a demonstration version of an application program* (E.g. Heath – col. 3:7-20, Information in the downloaded catalog file, which at least includes the list of names and version... information such as rating, for the purpose of sharing, could very well included in the catalog).

20. With respect to claim 16, Heath further discloses *wherein said demarked plurality of files comprises executable program instructions* (E.g. see Heath – col. 1:56-62, executable codes, library files).

21. With respect to claim 17, Heath further discloses *wherein said demarked plurality of files comprises non-executable information* (E.g. see Heath – col. 1:56-62, parameter files, and data files).

22. With respect to claim 21, Heath further discloses *wherein said transferring files indicated by said selected list is from said first hand held computer system to said second hand held computer system* (E.g. Heath – col. 1:49-55).

23. With respect to claim 37, Heath discloses *a method of software distribution comprising:*

- *maintaining, within a first hand held computer system, a plurality of computer files, wherein each computer file has associated with it a respective summary information* (E.g. see Heath – col. 3:7-20, Information in the downloaded catalog file, which at least includes the list of names and version... information such as rating, for the purpose of sharing... included in the catalog, col. 4:64-5:4);
- *within said first hand held computer system, demarking a subset of said plurality of computer files* (E.g. Heath - refer to the same base of claim 1.1);
- *in response to a request, transferring summary information of said subset of files (a list of components) to a second hand held computer system* (E.g. Heath – Fig. 3A:306, col. 2:1-5, 3:7-16 and 4:41-48); and
- *in response to said first hand held computer system receiving a selected list of computer files, transferring computer files on said selected list to said second hand held computer system* (E.g. Heath – col. 1:49-55, automatically selecting to download and update).

24. With respect to claim 42, the rejection of base claim 37 is incorporated. Heath further discloses *wherein said summary information comprises:*

- *an identification of a corresponding computer file* (E.g. see Heath – col. 3:7-20, Information in the downloaded catalog file, which at least includes the list of names and version identifications of the components); and
- *a description of said corresponding computer file* (E.g. see Heath – col. 3:7-20).

25. With respect to claim 43, Heath further discloses *wherein said description comprises a rating* (E.g. see Heath – Fig. 3A:302-306, Fig. 2B, col. 3:7-20, Information

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in the downloaded catalog file, which at least includes the list of names and version... information such as rating, for the purpose of sharing, could very well included in the catalog);

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 11-13, 18-20, 22-36 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heath (US 6,006,034, hereinafter Heath), as applied in claims 1, 14 and 37 above, in view of Gross (US 6,372,974, hereinafter Gross).

28. With respect to claims 11 and 18, the rejection of base claims 1 and 14 are incorporated. Heath does not explicitly disclose the remaining features of claims 11 and 18. However, Gross teaches *wherein said transferring is performed wirelessly* (E.g. see Gross – col. 2:3-14).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the features taught by Gross with those taught by Heath to also adopt the method of transferring data wirelessly as such method is well known within an open-architecture networks.

29. With respect to claims 12 and 19, the rejection of base claims 11 and 14 are incorporated. Heath does not explicitly disclose the remaining features of claims 12 and

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19. However, Gross teaches *wherein said transferring is performed via infrared light signaling* (E.g. see Gross – 2:3-14).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the features taught by Gross with those taught by Heath to also adopt the method of transferring data by using the infrared light signaling as file transferring means via infrared light is a well known established protocols;

30. With respect to claims 13 and 20, the rejection of base claims 11 and 14 are incorporated. Heath does not explicitly disclose the remaining features of claims 13 and 20. However, Gross teaches *wherein said transferring is performed automatically in response to a Bluetooth communication between said first hand held computer system and said second hand held computer system* (E.g. see Gross – 2:3-14).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the features taught by Gross with those taught by Heath to also adopt the method of transferring data by using the Bluetooth as the file transferring means via Bluetooth is a well known established protocols.

31. With respect to claim 22, the rejection of base claim 14 is incorporated. Heath does not explicitly disclose the remaining features of claims 22. However, Gross teaches *wherein said transferring files indicated by said selected list is from another hand held computer system to said second hand held computer system* (E.g. Gross – col. 2:54-60, the player selects the file or files to be transferred).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the features taught by Gross with those taught by Heath to transfer files via a selected list for the benefit of providing a hand held computer system in specifying a selection of files to be transferred from another hand held computer system.

32. With respect to claim 23, Heath discloses *a hand held computer system comprising a memory coupled to a bus, said memory comprising instructions which when executed implement a method of software distribution, said method comprising:*

- *demarking a subset of a plurality of files stored on said hand held computer system to denote a demarked plurality of files (E.g. see Heath – col. 1:47-55, selecting to download and update on the needed; and at col. 4:63-65 selectively identify and retrieve required components); and*
- *transferring information of said demarked plurality of files to another hand held computer system (E.g. see Heath – Fig. 3A Retrieve catalog file from server using launcher 302, and at col. 4:46-48).*

Health does not specifically disclose the remaining features of claim 23. However, Gross teaches *wherein*:

- *a bus (See Gross – FIG. 1);*
- *a processor coupled to said bus (E.g. see Gross – FIG. 2:24);*
- *a wireless transceiver coupled to said bus for transferring information to other computer systems (E.g. see Gross – FIG. 1:14);*

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the features taught by Gross with those taught by Heath to also include the wireless interface for the benefit of dynamically transferring content directly between portable devices in a client-server environment via some wireless transferring means (E.g. Gross – title, col. 1:7-9 and 1:33:37; col. 2:12-14), and being independent of accessibility to a host computer (E.g. see Gross – col. 2:1-2).

33. With respect to claim 24, the rejection of base claim 23 is incorporated. Heath further discloses *wherein said demarked plurality of files comprises executable program instructions* (E.g. see Heath – col. 1:56-62, executable codes, library files).

34. With respect to claim 25, the rejection of base claim 23 is incorporated. Heath further discloses *wherein said demarked plurality of files comprises non-executable information* (E.g. see Heath – col. 1:56-62, parameter files, and data files).

35. With respect to claim 26, the rejection of base claim 23 is incorporated. Heath further discloses *wherein said information of said demarked plurality of files comprises a rating of said demarked plurality of files* (E.g. see Heath – Fig. 3A:302-306, Fig. 2B, col. 3:7-20, Information in the downloaded catalog file, which at least includes the list of names and version... information such as rating, for the purpose of sharing, could very well included in the catalog);

36. With respect to claim 27, the rejection of base claim 23 is incorporated. Heath further discloses *wherein said information of said demarked plurality of files comprises*

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titles (names) of said demarked plurality of files (E.g. see Heath – col. 3:12-16, includes the list of names and version id).

37. With respect to claim 28, the rejection of base claim 23 is incorporated. Heath further discloses *wherein said information of said demarked plurality of files comprises storage requirements of said demarked plurality of files* (E.g. see Heath – col. 4:64-5:4, the catalog file includes at 324 a version identification, code or data size).

38. With respect to claims 29 and 30, the rejection of base claims 23 and 29 are respectively incorporated. Heath further discloses *wherein said information of said demarked plurality of files comprises an alphanumerical summary of said demarked plurality of files* (E.g. see Heath – col. 3:7-20, Information in the downloaded catalog file, which at least includes the list of names and version... information such as rating, for the purpose of sharing... included in the catalog, col. 4:64-5:4).

39. With respect to claim 31, Heath further discloses *wherein said information of said demarked plurality of files comprises a universal resource locator (hypertext link) for said demarked plurality of files* (E.g. see Heath – col. 3:20-27).

40. With respect to claim 32, Heath further discloses *wherein said information of said demarked plurality of files comprises an estimated transfer time for said demarked plurality of files* (E.g. see Heath – Fig. 5:508; col. 7:5-32).

41. With respect to claim 33, the rejection of base claim 23 is incorporated. Heath does not explicitly disclose the remaining features of claim 33. However, Gross teaches *wherein said transferring is performed wirelessly* (E.g. see Gross – col. 2:3-14).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the features taught by Gross with those taught by Heath to adopt the method of transferring files wirelessly as such method is well known within an open-architecture networks.

42. With respect to claim 34, the rejection of base claim 33 is incorporated. Heath does not explicitly disclose the remaining features of claim 34. However, Gross teaches *wherein said transferring is performed via infrared light signaling* (E.g. see Gross – 2:3-14).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the features taught by Gross with those taught by Heath to also adopt the method of transferring data by using the infrared light signaling as file transferring means via infrared light is a well known established protocols.

43. With respect to claim 35, the rejection of base claim 33 is incorporated. Heath does not explicitly disclose the remaining features of claim 35. However, Gross teaches *wherein said transferring is performed automatically in response to a Bluetooth communication between said first hand held computer system and said second hand held computer system* (E.g. see Gross – 2:3-14).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the features taught by Gross with those taught by Heath to also adopt the method of transferring data by using the Bluetooth as the file transferring means via Bluetooth is a well known established protocols

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44. With respect to claim 36, the rejection of base claim 23 is incorporated. Heath further discloses *wherein said method further comprises:*

- *in response to a selected list generated by said another hand held computer, automatically transferring files indicated by said selected list from said hand held computer system to said another hand held computer system (E.g. Heath – col. 1:49-55, automatically selecting to download and update).*

45. With respect to claim 38, the rejection of base claim 37 is incorporated. Heath does not explicitly disclose the remaining features of claim 38. However, Gross teaches *wherein said transferring are performed wirelessly between first and second hand held computer systems (E.g. see Gross – col. 2:3-14).*

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the features taught by Gross with those taught by Heath to adopt the method of transferring files wirelessly as such method is well known within an open-architecture networks.

46. With respect to claim 39, the rejection of base claim 38 is incorporated. Heath does not explicitly disclose the remaining features of claim 39. However, Gross teaches *wherein said transferring is performed using infrared communication (E.g. see Gross – 2:3-14).*

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the features taught by Gross with those taught by Heath to also adopt the method of transferring data by using the infrared light

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signaling as file transferring means via infrared light is a well known established protocols.

47. With respect to claim 40, the rejection of base claim 38 is incorporated. Heath does not explicitly disclose the remaining features of claim 40. However, Gross teaches *wherein said transferring are performed using Bluetooth communication* (E.g. see Gross – 2:3-14).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the features taught by Gross with those taught by Heath to also adopt the method of transferring data by using the Bluetooth as the file transferring means via Bluetooth is a well known established protocols.

48. With respect to claim 41, the rejection of base claim 37 is incorporated. Heath further discloses *wherein comprising said second hand held computer system generating said selected list in response to receiving said summary information of said subset of files as transferred in said second hand held computer system* (E.g. Heath – Fig. 2B:23-29).

Conclusion

49. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

50. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Wang whose telephone number is (571) 272-7954. The examiner can normally be reached on 8:00-4:30 M-F.

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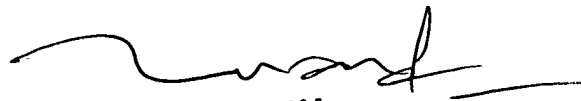
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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December 10, 2004

TDW



TUAN DAM
SUPERVISORY PATENT EXAMINER